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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/874,563	06/05/2001	John Atcheson	REALNET.054C1C1	6917

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EXAMINER

HAYES, JOHN W

ART UNIT PAPER NUMBER

3621

DATE MAILED: 01/23/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

8K

Office Action Summary

Application No.

09/874,563

Applicant(s)

ATCHESON ET AL.

Examiner

John W Hayes

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED. (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 June 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05 June 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>3</u> . | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 4-5 and 7-10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In **Claim 4**, "the ... first user input device, second user input device" lack antecedent basis.

In **Claim 5**, it is not clear what "it" refers to.

In **Claim 8**, it is not clear why the means for determining that the user preference matches the first preference is provided since the means for accepting signals requires that the user preference is the same as the first preference. Also, "the correlated second preference" lacks clear antecedent basis.

In **Claims 9-10**, it is not clear how the recited method or system provides meaningful recommendations as the output is merely the selections in the database that are not in the user's input of preferred selections. In other words, the recitation of "associated" music selections is vague. Further, it is not clear why the processor determines the number "n" when it is never used.

Claim 7 is rejected because by its dependency it includes the language of a rejected base claim.

Double Patenting

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

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Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 1-14 are rejected under the judicially created doctrine of obviousness type double patenting as being unpatentable over claims 1-23 of U.S. Patent No. 5,583,763. Although the conflicting claims are not identical, they are not patentably distinct from each other because deletion of a feature with a corresponding loss of function has been held to be obvious.

Instant claim 1 is a broader version of patented claim 1. While patented claim 1 further includes the steps of assigning each of the matching records a match count, identifying unmatched preferences, assigning a weight to an unmatched preference and ranking the unmatched preferences, the deletion of these features would have been obvious to those of ordinary skill in the art. See *In re Karlson*, 136 USPQ 184. Omission of a feature whose function is not needed would have been obvious to those of ordinary skill in the art.

Alternately, as the instant claims make use of the term "comprising" and are supported by the same specification as the narrower patented claims, the instant claims also provide protection for the subject matter recited in the patented claims. See *In re Schneller*, 158 USPQ 210. The recitations in the remainder of the instant claims are either specifically provided for in patented claims or represent broader versions of the patented claims and are thus rejected for the reasons applied to claim 1.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is

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advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

7. Claims 1-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hey, U.S. Patent No. 4,996,642.

Hey teaches a system and method for recommending items, including movies and music, to a selected user from a database of items sampled by other user and not the selected user. Hey further teaches that the system includes a keyboard input, display, processing means and a database that stores files indicating each user's sampled items and their rating for the sampled item. The database is searched to match the selected user's sampled items with those of the other users. After matching and additional processing, other users files are identified as "recommending users" due to the degree of agreement between the identified files and the selected user's file. From the recommending users' files Hey determines and ranks non-matching items and presents the list to the selected user. Hey also teaches that the system can receive input or provide output to a remote user. See the entire document of Hey.

While Hey does not specifically teach the use of a threshold number of matches to identify the recommending users, Hey does teach that in determining the "agreement scalar" that is used to identify the recommending users, the number of items sampled by both members is considered in the calculation of the agreement scalar. Hey also teaches that "it is evident that the greater the number of items that the users have sampled, the more accurate the agreement scalar should be for each of the users with which the selected user is paired". As Hey is obviously interested in providing accurate recommendations of items, as a Hey teaches that low number of items sampled in common decreases accuracy, and as thresholding is a well known technique for eliminating conditions that do not warrant consideration, it would have been obvious to those of ordinary skill in the art to modify the teachings of Hey to include well known thresholding in order to increase accuracy of recommendations and to save processing time on user files that would obviously yield unacceptable agreement scalars. With regard to the number of items

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in the file and the threshold number, these limitations would have been an obvious matter of design optimization to those of ordinary skill in the art for the accuracy desired and the storage space available.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to John Hayes whose telephone number is (703)306-5447. The examiner can normally be reached Monday through Friday from 5:30 to 3:00.

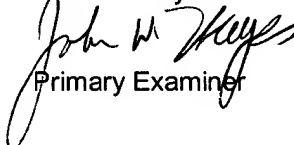
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jim Trammell, can be reached on (703) 305-9768.

The Fax phone number for the **UNOFFICIAL FAX** for the organization where this application or proceeding is assigned is (703) 746-5531 (for informal or draft communications, please label "PROPOSED" or "DRAFT").

The Fax phone number for the **OFFICIAL FAX** for the organization where this application or proceeding is assigned is (703) 305-7687 (for formal communications intended for entry including After-Final communications).

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.

John W. Hayes



Primary Examiner

21 January 2003